



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,339	08/16/2001	John Allen	512426-2003	2639

20999 7590 10/16/2003

FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/931,339

Applicant(s)

ALLEN ET AL.

Examiner

Sanza L McClendon

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 23-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 14, 16, 17 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 7, 12, 13 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1711

DETAILED ACTION

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-22, drawn to organosiloxane compositions, classified in class 522, subclass 99.
  - II. Claims 23-37, drawn to organosiloxane compositions, classified in class 522, subclass 99.
  - III. Claims 38-52, drawn to organosiloxane compositions, classified in class 522, subclass 99.
  - IV. Claims 53-67, drawn to organosiloxane compositions, classified in class 522, subclass 99.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are distinct and capable of supporting their own patents.
3. Inventions I and III are distinct and capable of supporting their own patents.
4. Inventions I and IV are distinct and capable of supporting their own patents.
5. Inventions II and III are distinct and capable of supporting their own patents.
6. Inventions II and IV are distinct and capable of supporting their own patents.
7. Inventions III and IV are distinct and capable of supporting their own patents.
8. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.
9. During a telephone conversation with William Lawrence on September 24, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-67 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one

Art Unit: 1711

claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Claim Rejections - 35 USC § 102*

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-5, 8, 14, 16-17, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Okinoshima et al (6,069,186).

Okinoshima et al teaches radiation curable silicone rubber compositions use in applications as taught in column 16. Said composition comprises a organopolysiloxane having (meth) acryloyl groups at both terminal of the molecular chain, a photosensitizer, a tetraalkoxysilane or a partial hydrolysis condensation product thereof, and optionally a organic titanium compound, which when irradiated produce coatings that have superior adhesion to substrates. In addition, said composition can comprise inorganic fillers, such as fumed silica, silica aerogel, quartz powder, titanium oxide, calcium carbonate—see column 14, lines 40-60. Okinoshima et al teaches making compound exemplified by formulas 1-12 to 1-23, which appear to anticipate component (a) of applicant's invention. Said photo-sensitizer can be found in column 11 to column 12 and used in amounts from 0.5 to 10 parts by weight. Said alkoxysilane and/or the partial hydrolysis condensation product anticipates component (b) of applicant's invention.

13. Claims 1-6, 9-11, 14, 16, 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Irifune et al (EP 0 624 627).

Irifune et al teaches radiation curable organopolysiloxane compositions. Said composition comprises a blend of a first and second (meth) acryloxyalkyl-containing

Art Unit: 1711

organopolysiloxane in combination with a photoinitiator. Said first organosiloxane is a high molecular weight organosiloxane exemplified by formulas VI and VII, wherein these appear to anticipate applicants' (a) component. Said second organosiloxane is a low molecular weight organosiloxane exemplified by formulas I and II, wherein these appear to anticipate applicant's (b) component. Said blend in combination with a photoinitiator in amounts up to 3 parts by weight, are cured using UV radiation to produce coatings having adhesive properties, such as found in PSAs—see page 3.

*Claim Rejections - 35 USC § 112*

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 does not have the definition for b', wherein this renders the formula incomplete and the claims unclear. Appropriate clarification is requested.

*Allowable Subject Matter*

16. Claims 7, 12-13, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach organopolysiloxanes as taught by the formula for component (a), wherein -Y-G- is a compound found in claim 7. Nor does it teach organopolysiloxanes as described by applicant having fillers modified with the components in claims 12-13 and 18.

Art Unit: 1711

*Conclusion*

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

Sanza L McClendon

Examiner

Art Unit 1711

SMc



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700